

United States District Court

For the Northern District of California

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

HANK SPACONE, on behalf of and as
Trustee for the General Unsecured
Creditors' Liquidating Trust of At
Home Corporation, and on behalf of and
in the name of the At Home Liquidating
Trust of At Home Corporation,

Plaintiff,

v.

MICROSOFT CORPORATION,

Defendant/Counterclaim
Plaintiff,

v.

HANK SPACONE, on behalf of and as
Trustee for the General Unsecured
Creditors' Liquidating Trust of At
Home Corporation, and on behalf of and
in the name of the At Home Liquidating
Trust of At Home Corporation, and
JACQUELYN CRAWFORD, as Trustee for the
At Home Liquidating Trust of At Home
Corporation,

Counterclaim Defendants.

No. C 03-4739 CW

ORDER ON CROSS-
MOTIONS FOR
SUMMARY JUDGMENT

_____ /

1 Plaintiff and Counter-defendant Hank Spacone, on behalf of and
2 as Trustee for the General Unsecured Creditors' Liquidating Trust
3 of At Home Corporation, and on behalf of and in the name of the At
4 Home Liquidating Trust of At Home Corporation, moves for partial
5 summary judgment that Defendant and Counter-claimant Microsoft
6 Corporation infringes various claims of the patent-in-suit, that
7 claim 8 of the patent is valid and that Defendant's theories of
8 invalidity under §§ 101 and 112 and laches fail, as a matter of
9 law. Defendant opposes the motion, and cross moves for summary
10 judgment of non-infringement of all asserted claims and invalidity
11 of all claims except claim 8.¹ The matter was heard on January 13,
12 2006. Having considered all of the papers filed by the parties,
13 the evidence cited therein and oral argument on the motion, the
14 Court grants in part Plaintiff's motion for partial summary
15 judgment and denies it in part and grants Defendant's motion for
16 summary judgment.

17 BACKGROUND

18 At Home Corporation (At Home) was an internet service provider
19 that provided high-speed internet connections through cable
20 infrastructure. On September 19, 2000, At Home was issued U.S.
21 Patent No. 6,122,647 (the '647 patent), entitled "Dynamic
22 Generation of Contextual Links in Hypertext Documents." The
23 application corresponding to the '647 patent was filed on May 19,
24

25 ¹Defendant notes, however, that it does not oppose the
26 portions of Plaintiff's motion directed to Defendant's affirmative
27 defenses based on 35 U.S.C. §§ 101 and 112 and laches, and that it
28 will grant Plaintiff's motion with respect to those defenses.

1 1998.

2 The Background of the patent represents as follows. The World
3 Wide Web is today's most commonly used information retrieval
4 system, and one of the distinguishing features of documents on the
5 web is the use of hypertext links that associate a portion of one
6 document with another document. '647 patent, 1:13-16. In
7 conventional hypertext documents, links were statically defined and
8 when a user accessed the source document, the links were provided
9 exactly as defined by the creator/editor. This had several
10 drawbacks, including that a link could only refer to documents that
11 existed at the time the link was defined; after the source document
12 and its links were defined, it could be immediately out-of-date.
13 '647 patent, 1:55-59. There were, however, systems, such as search
14 engines, that could automatically generate hypertext links. But
15 even those more advanced search systems were limited in their
16 capabilities and were not dynamic in nature. Once a user accessed
17 a referenced document in the search result, the search engine was
18 then incapable of providing any analysis of the referenced
19 document. '647 patent, 2:21-30.

20 The '647 patent teaches how to overcome the limitations of
21 conventional information retrieval systems "by providing a system
22 and method that dynamically generates contextual hypertext links in
23 a source document to other topically relevant documents in response
24 to the content of the source document or user-selected portion
25 thereof." '647 patent, 41-48. The patent enables users to see
26 only those documents that are relevant to their subject of interest
27 in the current context, rather than all documents related to the
28

1 current document they are accessing or the terms it contains, and
2 to navigate through documents based on topical subjects, rather
3 than by the terms that occur in the documents. Furthermore, the
4 patented technology automatically ensures that target documents are
5 live and current, not static or stale.

6 Defendant develops, sells and produces computer software with
7 smart tag functionality that Plaintiff alleges infringes the '647
8 patent. Smart tags are a feature of Word, Excel and PowerPoint
9 2003; smart tags are capable of recognizing data types including
10 names, dates, times, addresses, places, telephone numbers, recent
11 e-mail recipients and financial symbols. Higashiyama Dec., ¶ 2, 4.
12 A number of smart tag recognizers are provided "out of the box" in
13 Word. Id. at ¶ 4. Other of Defendant's programs, Microsoft
14 Outlook, Internet Explorer and Access 2003, do not recognize text,
15 but they do permit smart tag actions for previously recognized
16 text. Id. at ¶ 2.

17 Smart tags operate through a combination of two components:
18 recognizers and action handlers. Id. at ¶ 4. The action handlers
19 allow users to choose appropriate actions for specific data types,
20 such as place data or name data.

21 A user does not have to prompt the system or select any text
22 for smart tag recognition to occur. When a smart tag data type is
23 recognized in Word or PowerPoint, it is underlined with a purple
24 dotted line; when it is recognized in Excel, a small purple
25 triangle is placed in the corner of the spreadsheet cell. The
26 position of a smart tag and its data type are recorded in the Word,
27 Excel or PowerPoint document. Id. at ¶ 6.

1 At the time of recognition, the smart tag or its data type is
2 not linked to or associated with any other entity or document. Id.
3 at ¶ 7. After recognition, nothing happens unless the user decides
4 to invoke the action handler. Id. at ¶ 8. The action handler
5 controls the actions allowed for each smart tag data type. If the
6 cursor is positioned over the underlined text or purple triangle,
7 or if the smart tag text is selected, a smart tag icon will appear.
8 If the user clicks on this icon, an action handler is invoked and
9 displays a menu which lists possible actions for that data type.
10 Each data type has its own pre-determined group of actions to
11 choose from; the user can select an action by clicking on a menu
12 item and the action will then be carried out. Id. at ¶ 9. The
13 financial symbol and address smart tags are the two data types
14 provided by Defendant out of the box that allow the user to search
15 for and access external information. Id. at ¶ 5. A financial
16 symbol, or stock ticker, smart tag can search for and access
17 information related to a stock price, company report or company
18 news; an address smart tag can search for and access information in
19 the form of a map or directions. Id.

20 LEGAL STANDARD

21 Summary judgment is properly granted when no genuine and
22 disputed issues of material fact remain, and when, viewing the
23 evidence most favorably to the non-moving party, the movant is
24 clearly entitled to prevail as a matter of law. Fed. R. Civ.
25 P. 56; Celotex Corp. v. Catrett, 477 U.S. 317, 322-23 (1986);
26 Eisenberg v. Ins. Co. of N. Am., 815 F.2d 1285, 1288-89 (9th Cir.
27 1987).

1 The moving party bears the burden of showing that there is no
2 material factual dispute. Therefore, the court must regard as true
3 the opposing party's evidence, if supported by affidavits or other
4 evidentiary material. Celotex, 477 U.S. at 324; Eisenberg, 815
5 F.2d at 1289. The court must draw all reasonable inferences in
6 favor of the party against whom summary judgment is sought.
7 Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574,
8 587 (1986); Intel Corp. v. Hartford Accident & Indem. Co., 952 F.2d
9 1551, 1558 (9th Cir. 1991).

10 Material facts which would preclude entry of summary judgment
11 are those which, under applicable substantive law, may affect the
12 outcome of the case. The substantive law will identify which facts
13 are material. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248
14 (1986).

15 Where the moving party does not bear the burden of proof on an
16 issue at trial, the moving party may discharge its burden of
17 showing that no genuine issue of material fact remains by
18 demonstrating that "there is an absence of evidence to support the
19 nonmoving party's case." Celotex, 477 U.S. at 325. The moving
20 party is not required to produce evidence showing the absence of a
21 material fact on such issues, nor must the moving party support its
22 motion with evidence negating the non-moving party's claim. Id.;
23 see also Lujan v. Nat'l Wildlife Fed'n, 497 U.S. 871, 885 (1990);
24 Bhan v. NME Hosps., Inc., 929 F.2d 1404, 1409 (9th Cir. 1991),
25 cert. denied, 502 U.S. 994 (1991). If the moving party shows an
26 absence of evidence to support the non-moving party's case, the
27 burden then shifts to the opposing party to produce "specific
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1 evidence, through affidavits or admissible discovery material, to
2 show that the dispute exists." Bhan, 929 F.2d at 1409. A complete
3 failure of proof concerning an essential element of the non-moving
4 party's case necessarily renders all other facts immaterial.
5 Celotex, 477 U.S. at 323.

6 Where the moving party bears the burden of proof on an issue
7 at trial, it must, in order to discharge its burden of showing that
8 no genuine issue of material fact remains, make a prima facie
9 showing in support of its position on that issue. See UA Local 343
10 v. Nor-Cal Plumbing, Inc., 48 F.3d 1465, 1471 (9th Cir. 1994).

11 That is, the moving party must present evidence that, if
12 uncontroverted at trial, would entitle it to prevail on that issue.
13 See id.; see also Int'l Shortstop, Inc. v. Rally's, Inc., 939 F.2d
14 1257, 1264-65 (5th Cir. 1991). Once it has done so, the non-moving
15 party must set forth specific facts controverting the moving
16 party's prima facie case. See UA Local 343, 48 F.3d at 1471. The
17 non-moving party's "burden of contradicting [the moving party's]
18 evidence is not negligible." Id. This standard does not change
19 merely because resolution of the relevant issue is "highly fact
20 specific." See id.

21 DISCUSSION

22 I. Infringement

23 As the Federal Circuit states, "An infringement analysis is a
24 two-step process in which the court first determines, as a matter
25 of law, the correct claim scope, and then compares the
26 properly-construed claim to the accused device to determine, as a
27 matter of fact, whether all of the claim limitations are present,

1 either literally or by a substantial equivalent, in the accused
2 device." Johnson Worldwide Assoc., Inc. v. Zebco Corp., 175 F.3d
3 985, 988 (Fed. Cir. 1999). The Court has already completed the
4 first step and only the second step remains.

5 A. Smart Tags

6 Before the Court can examine whether smart tags infringe, the
7 Court must first determine which smart tag types are at issue.
8 Defendant contends that Plaintiff addresses only the stock ticker
9 smart tag in Microsoft Word 2002 and 2003. It argues that, because
10 Plaintiff never identified the stock ticker smart tag in his Final
11 Infringement Contentions, the Court should not allow Plaintiff to
12 pursue the stock ticker claim. In the alternative, Defendant
13 argues that Plaintiff has provided no analysis of the other smart
14 tag types, such as telephone number, date, person and place, which
15 do not have the same functionality as the stock ticker smart tag;
16 thus, Defendant contends that it is entitled to summary judgment
17 that these other smart tag types do not infringe. In a footnote in
18 his reply, Plaintiff responds that these arguments are nonsense; he
19 addresses them in his opposition to Defendant's motion to strike.

20 Defendant's argument that Plaintiff cannot bring a claim based
21 on the stock ticker smart tag merely because it was not identified
22 in Plaintiff's final infringement contentions is not persuasive.
23 The cases Defendant cites are distinguishable. And, as Plaintiff
24 notes, the stock ticker smart tag is an example of the alleged
25 infringing activity; it did not need to be specifically listed on
26 Plaintiff's final infringement contentions.

27 Defendant's argument that Plaintiff has failed to meet his
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1 burden with other smart tag types, however, is compelling.
2 Plaintiff did not need to list and analyze every type of smart tag
3 in his final infringement contentions. But to defeat this motion
4 for summary judgment, in which Defendant contends that there is an
5 absence of evidence to support infringement by any smart tags other
6 than the stock ticker smart tags found in Word, Plaintiff must
7 produce specific evidence regarding every smart tag type.
8 Plaintiff does not. Plaintiff provides evidence regarding
9 third-party smart tags and smart tags in other applications, such
10 as Excel and PowerPoint; however, Plaintiff does not provide
11 evidence regarding other smart tag types. Directly referring to
12 smart tag types is not enough. As noted above, Defendant includes
13 a declaration stating that the stock ticker and address smart tags
14 are the only two smart tag types provided by Defendant out of the
15 box that can search for and access external information. The
16 telephone number smart tag, for example, only gives the user the
17 option of adding that telephone number to Outlook Contacts; it does
18 not access the Internet. Plaintiff provides no evidence to create
19 a dispute that the other smart tag types, like the name and date,
20 have the same functions as the stock ticker and address smart tags.
21 Thus, the Court concludes that only the stock ticker, address and
22 third-party smart tags remain at issue in this case, and, using the
23 stock ticker tag as the example,² the Court will consider whether
24 these smart tag types infringe the '647 patent.

25
26 ²Plaintiff's evidence regarding third-party smart tags does
27 not show that these tags operate any differently than the stock
28 ticker tag. See Soffer Dec. ¶¶ 16, 27-31.

1 B. Literal Infringement

2 The parties cross-move for summary judgment on literal
3 infringement, both asserting that there are no material factual
4 disputes. Plaintiff claims that Defendant's smart tags
5 functionality, which consists of the smart tags features in
6 Defendant's Office and Windows products, and the related software
7 modules, program and tools that support its functionality, is
8 indistinguishable from the '647 patent and thus literally infringes
9 the '647 patent. But Defendant contends that its smart tags
10 feature takes an approach to accessing information that is entirely
11 different from that of the '647 patent and thus it does not
12 infringe any of the asserted claims.

13 1. Hypertext Links (Claims 1, 2, 6, 8, 11, 12 and 13)

14 All of the asserted claims require a hypertext link.³ The
15 Court defined hypertext link as "a computer implemented association
16 between a portion of the source document and a target document that
17 includes an anchor and information sufficient to get to a network
18 location of the target document, and allows a user to navigate from
19 the source document to the target document by activation of the
20 link anchor and thereby retrieve the target document."

21 Plaintiff argues that Microsoft's own literature indicates
22 that smart tags generate hyperlinks. For example, PressPass, an
23 online resource providing information for journalists, titled
24 "Office XP Adds New Tools and Innovations to Foundation of Past
25 Versions," states:

26 ³ "Hypertext link," "link" and "hyperlink" are synonymous and
27 are used interchangeably.

1 Smart tags work like automatic hyperlinks with multiple
2 options. They search and offer direct access to Web
3 sites, personal notes and other documents that expand on
4 the information on the user's screen. For example, if a
5 user types one of thousands of company stock-ticker
names, Word creates a tag with links to a variety of
information, such as company reports, stock information
or news from MSN Money Central. Smart tags provide more
power than simple hyperlinks.

6 Soffer Dec., Ex. Q at MSM 14540. And Defendant's tutorial on how
7 to create an XML list description explains:

8 Test out the smart tag list One of the action
9 options in the list should be "View A. Datum Website".
Click this command to go to the hypothetical Web site.
10 The other action option should be "A. Datum Corporation
Company Reports", which is also a hyperlink.

11 Soffer Dec., Ex. B at 10522.

12 Defendant responds that there is no evidence that it uses
13 hyperlinks as defined by the Court and that smart tags do not have
14 a hyperlink as defined by the Court. Defendant argues that
15 Plaintiff's characterization of the menu action items as the
16 hyperlinks fails because these menu items do not include an
17 "anchor," as required by the Court's claim construction.
18 Plaintiff, however, responds that he did not assert that the menu
19 action items are hypertext links. Plaintiff points to deposition
20 testimony of his expert Stuart B. Soffer, who, when asked if he was
21 equating, for the purposes of claim 6, the action items with
22 hypertext links, responded, "No. They are representative of the
23 hypertext links" Supp. Smith Dec., Ex. A at 117:21-24;
24 119:3-6 (menus items are "simplified titles" for hypertext links).
25 Plaintiff does not attempt to reconcile this testimony with Mr.
26 Soffer's testimony that, in the stock ticker smart tag, the
27 hypertext links that are presented to the user are "going to be the
28

1 three actions" in the menu. Bush Dec., Ex. B. at 169:3-5.

2 Instead, Plaintiff notes that his position that menu items are
3 representative of the hypertext links is consistent with the '647
4 patent specification, which states,

5 If there is more than one link for the tag, then a menu
6 of links to target documents is created at the link
7 anchor. In this implementation, dynamic HTML (DHTML) is
used to create the menu of links, with each link being
named by a simplified title.

8 '647 patent at 10:28-32.

9 But the problem with this position is that, although Plaintiff
10 states that smart tags functionality generates hyperlinks as
11 construed by the Court, Plaintiff fails to identify in his briefs
12 what in smart tags technology is the alleged hypertext link. Nor
13 was Plaintiff able adequately to identify at the hearing what in
14 smart tags is the hypertext link; instead, Plaintiff listed several
15 elements that create an "effective hyperlink." Furthermore, as
16 Defendant notes, Plaintiff's position cannot be reconciled with his
17 allegation that smart tags infringe claim 6, which expressly
18 requires a menu of hypertext links, and for which Plaintiff points
19 to the menu of action items. See Bush Dec., Ex. A at 11 (Claim
20 Chart). Plaintiff has the burden of providing evidence to dispute
21 Defendant's contention that smart tags lack hyperlinks as construed
22 by the Court. He cannot, and does not, meet his burden by merely
23 stating that the menu items represent hypertext links. Therefore,
24 the Court grants Defendant summary judgment that its smart tags do
25 not literally infringe claims 1, 2, 6, 8, 11, 12 and 13 of the '647
26 patent.

2. Topics (Claims 2, 8, 12 and 13)

Claims 2, 8, 12 and 13 require determining at least one topic associated with each selected term. Plaintiff's final infringement contentions provide, "Recognized text is tagged as being associated with data type, i.e., topic, to thereby determine topics in the knowledge base associated with the selected terms relevant to the user selected portion." Plaintiff's opening brief, however, provides, "While the type information itself is not necessarily a topic, it is indicative of a topic." Defendant argues that Plaintiff abandoned his theory that a data type is a topic and adopted new theories of infringement, violating the Patent Local Rules because the new theories were not disclosed in Plaintiff's infringement contentions, and thus the Court should not consider them. See Integrated Circuit Systems, Inc. v. Realtek Semiconductor Co., Ltd., 308 F. Supp. 2d 1106, 1107 (N.D. Cal. 2004) (quoting Atmel Corp. v. Info. Storage Devices, Inc., 1998 WL 775115 at 2-3 (N.D. Cal. Nov. 5, 1998)) ("The patent local rules were adopted by this district in order to give claim charts more 'bite.' The rules are designed to require parties to crystallize their theories of the case early in the litigation and to adhere to those theories once they have been disclosed. . . . Unlike the liberal policy for amending pleadings, the philosophy behind amending claim charts is decidedly conservative, and designed to prevent the 'shifting sands' approach to claim construction [and] ensure that litigants put all their cards on the table up front."). In his reply, Plaintiff does not respond to Defendant's request that the Court hold him to the theory he advanced in his final

1 infringement contentions. Regardless, the Court will address
2 Plaintiff's new theories of infringement.

3 In his motion for summary judgment, Plaintiff identifies the
4 words "Microsoft Corporation," as a "topic." Defendant argues
5 that, because the words Microsoft Corporation are not stored in the
6 smart tag infrastructure, smart tags cannot determine topics, as
7 required by the patent. Plaintiff does not dispute that the words
8 Microsoft Corporation are not stored in the smart tags
9 infrastructure. Rather, Plaintiff asserts that a topic can be
10 represented by a "topic ID," such as, in this example, "MSFT,"
11 which Plaintiff states "is exactly what Smart Tags Functionality
12 does." See '647 patent at 5:60-62 ("Each topic in the knowledge
13 base 120 may have a unique topic ID code for cross-referencing in
14 other tables."). But, as Defendant notes, Plaintiff provides no
15 evidence in support of this assertion; Plaintiff's statement that
16 this "is exactly what smart tag functionality does" is unsupported
17 by any citation to the record. This "topic ID" theory is not found
18 in Plaintiff's final infringement contentions; nor does Plaintiff
19 point to any mention of it in Plaintiff's expert reports. The
20 claim language requires topics and not topic ID codes; topics and
21 topic ID codes are not synonymous.

22 Plaintiff again fails to meet his burden of providing specific
23 evidence to show that a dispute exists. Thus, for this additional
24 reason, the Court grants Defendant summary judgment that its smart
25 tags do not literally infringe claims 2, 8, 12 and 13 of the '647
26 patent.

1 3. Presentation and Tagging Modules (Claim 8)

2 Claim 8 requires three separate modules: a knowledge base, a
3 tagging module and a presentation module. In its claim
4 construction order, the Court defined presentation module as:

5 A software product stored on computer readable media and
6 executable by a computer that is connected to exchange
7 information with the knowledge base, and that is operative
8 to receive the user selected portion of the source
9 document and the selected terms determined by the tagging
10 module, and for each selected term, (1) determines the
11 topics associated with the term, and the at least one
12 document associated with each topic, (2) creates hypertext
13 links to the at least one document associated with the
14 topics, (3) associates the hypertext links with the source
15 document, and (4) presents hypertext links to the user
16 interface.

17 W. Bruce Croft, Defendant's expert, explains that, under
18 claim 8, the tagging module must "receive a user selected
19 portion of the source document," and the presentation module
20 must be "operative to receive the user selected portion of the
21 source document." According to Dr. Croft, smart tags do not
22 meet this limitation because there is no portion of the smart
23 tags source code that receives "any user selected portion"
24 twice. Croft Dec., Ex. A at ¶ 77. Defendant argues that
25 Plaintiff fails to offer any evidence that the smart tag
26 functions are "operative to receive the user selected portion
27 of the source document," as required by claim 8.

28 Plaintiff responds that there is nothing in the claim or
the Court's construction requiring that the receipt of a user
selected portion by the tagging and presentation modules be
accomplished in two separate steps or by two different pieces
of software code. That is incorrect. As Defendant notes,

1 claim 8 requires two separate modules: the tagging module
2 "receiv[es] a user selected portion of the source document,"
3 and the presentation module "receive[s] the user selected
4 portion." In Process Control Corp. v. HydReclaim Corp., 190
5 F.3d 1350, 1356 (Fed. Cir. 1999), the court explained, "It is
6 clear from the language of the claim itself that the term 'a
7 discharge rate' in clause [b] is referring to the same rate as
8 the term 'the discharge rate' in clause [d]." Here, it is also
9 clear that the "the user selected portion" that the
10 presentation model receives is the same user selected portion
11 that the tagging module receives. The claim does not, as
12 Plaintiff contends, need to say "first" and "second."
13 Defendant correctly notes that the case Plaintiff cites does
14 not hold that a claim must use the terms "first" and "second"
15 to distinguish between multiple instances of the same
16 limitation; instead, the case addressed whether the terms
17 "first pattern" and "second patten" impose a serial or temporal
18 limitation on when the patterns are created. See 3M Innovative
19 Props. Co. v. Avery Dennison Corp., 350 F.3d 1365, 1371 (Fed.
20 Cir. 2003).

21 Plaintiff fails to provide evidence that both the tagging
22 module and the presentation module receive the user selected
23 portion. "Made available to" is not the same as "received by."
24 Thus, for this additional reason, the Court finds that
25 Defendant does not literally infringe claim 8.

26 B. Doctrine of Equivalents

27 Defendant asserts that, in addition to summary judgment of
28

1 no literal infringement, it is entitled to summary judgment of
 2 no infringement by the doctrine of equivalents. According to
 3 Defendant, Plaintiff has offered only conclusory statements,
 4 and no evidence, that smart tags infringe any of the asserted
 5 claims under the doctrine of equivalents. See Croft Dec., Ex.
 6 A ¶ 96, 97. Plaintiff contends that, while he did not move for
 7 summary judgment under the doctrine of equivalents and thus did
 8 not present evidence in his moving papers, he has presented
 9 evidence; he cites to six paragraphs in Mr. Soffer's expert
 10 report and two paragraphs in his supplemental declaration.⁴

11
 12 ⁴Defendant moves to strike these two paragraph in its Motion
 13 to Strike Mr. Soffer's Untimely New Opinions Regarding the Doctrine
 14 of Equivalents. Responding to Defendant's argument, discussed
 15 above, that claim 8 requires the user selected portion to be
 16 received by both the tagging module and the presentation module,
 17 Mr. Soffer, for the first time, explains how claim 8 is infringed
 18 by smart tags under the doctrine of equivalents. Plaintiff argues
 19 that Defendant's motion to strike should be denied because Mr.
 20 Soffer presents no new theory of infringement and Defendant would
 21 not be prejudiced by its consideration. Plaintiff's argument that
 22 Defendant would not be prejudiced is persuasive. And Defendant
 23 does not dispute that it would be not prejudiced by the
 24 introduction of these two paragraphs. But Plaintiff's argument
 25 that this is not a new theory is not persuasive. Although the
 26 evidence Mr. Soffer relies on was disclosed in the expert report,
 27 the theory that claim 8 is infringed under the doctrine of
 28 equivalents was not disclosed. Plaintiff stated in his Final
 Infringement Contentions and expert report that if the smart tags
 do not literally infringe then they infringe under the doctrine of
 equivalents; claim 8, however, was not specifically mentioned.
 Plaintiff's argument that he could not have asserted this theory of
 infringement before because he did not know that Defendant believed
 that claim 8 requires that the user selected portion be received
 twice is not compelling. Nonetheless, reviewing the five factors
 the Ninth Circuit has instructed a district court to consider in
 determining whether a discovery sanction is appropriate, the Court
 DENIES Defendant's Motion to Strike (Docket No. 225). See Wendt v.
Host Intern., Inc., 125 F.3d 806, 814 (9th Cir. 1997) ((1) the
 public's interest in expeditious resolution of litigation; 2) the
 court's need to manage its docket; 3) the risk of prejudice to the
 parties; 4) the public policy favoring disposition of cases on
 their merits; 5) the availability of less drastic sanctions)).

1 Paragraphs forty to forty-four in the expert report,
2 however, make no mention of equivalents. And paragraph 101
3 contains only a conclusory catch-all statement:

4 In addition, if for any reason a claim limitation or
5 element of the '647 patent claims identified above are
6 found to not be literally infringed by Smart Tags
7 functionality, I conclude there is infringement under
8 the Doctrine of Equivalents. In particular, based on my
9 analysis, any aspect of Smart Tags functionality not
10 found to be literally within the scope of a particular
11 claim limitation or element is merely an insubstantial
12 change and that Smart Tags functionality includes
13 corresponding elements that perform substantially the
14 same function, in substantially the same way, to achieve
15 substantially the same result as the elements in claim
16 1, 2, 6, 8, 11, 12 and 13.

17 Soffer Dec. ¶ 104.

18 Apart from the two paragraphs in Mr. Soffer's Supplemental
19 Declaration, paragraph forty-five in the expert report is
20 Plaintiff's only attempt to address a specific limitation:

21 Finally, even were it determined that Smart Tags
22 functionality does not literally generate "hyperlinks",
23 Smart Tags functionality generates the equivalent of
24 "hyperlinks". Smart Tags functionality performs
25 substantially the same function (associating a target
26 document with a source document for document navigation
27 and retrieval), in substantially the same way (invoking
28 a routine for document navigation and retrieval), to
achieve substantially the same result (navigating to and
retrieving a target document from the source document).
Any difference is insubstantial.

Id. at 45. Defendant asserts that this "analysis by
parenthetical" is not enough for Plaintiff to meet his burden.

As the Federal Circuit has held, "Having presented the
district court with only conclusory statements regarding
equivalence, without any particularized evidence and linking
argument as to the 'insubstantiality of the differences'
between the claimed invention and the accused device," the

1 plaintiff is "foreclosed from invoking the substantive
2 application of the doctrine of equivalents." PC Connector
3 Solutions LLC v. SmartDisk Corp., 406 F.3d 1359, 1364 (Fed.
4 Cir. 2005); see also General Elec. Co. v. Nintendo Co., Ltd.,
5 179 F.3d 1350, 1359 (Fed. Cir. 1999) (affirming summary
6 judgment because "conclusory assertion of equivalence" was
7 "insufficient to establish a genuine issue of material fact"
8 and the plaintiff therefore failed to carry its burden).

9 In his opposition to Defendant's motion to strike the two
10 paragraphs from Mr. Soffer's supplemental declaration,
11 Plaintiff acknowledges that he has not presented detailed
12 doctrine of equivalents analyses for each asserted claim of the
13 '647 patent. Nonetheless, the Court determines that paragraph
14 45 and Mr. Soffer's supplemental declaration provide
15 evidentiary support, although minimal, for infringement under
16 the doctrine of equivalents, but only with respect to
17 hyperlinks in all of the asserted claims and the tagging and
18 presentation models of claim 8. Plaintiff does not provide
19 evidence of an equivalent of topics. Therefore, there is no
20 infringement, even under the doctrine of equivalents, of claims
21 2, 8, 12 and 13. The Court grants summary judgment to
22 Defendant of non-infringement, literally or by equivalents, of
23 claims 2, 8, 12 and 13. A dispute of fact remains in respect
24 to infringement by equivalents of the hyperlinks limitation in
25 claims 1, 6 and 11. However, as will be discussed below,
26 summary judgment is granted to Defendant on these claims as
27 well because they are invalid as anticipated.

1 II. Validity

2 Defendant argues that, as a matter of law, all of the
3 asserted claims, except claim 8, are invalid as anticipated.
4 See 35 U.S.C. § 102 (providing that a patent is invalid if the
5 invention disclosed was fully anticipated by a prior art
6 reference). Plaintiff argues that, as a matter of law, claim 8
7 is valid, neither anticipated nor obvious.

8 A patent is presumed to be valid. 35 U.S.C. § 282. A
9 party alleging that a patent is invalid bears the burden of
10 proof, id., and must overcome this statutory presumption of
11 validity by proving invalidity through clear and convincing
12 evidence. Ultra-Tex Surfaces, Inc. v. Hill Bros. Chem. Co.,
13 204 F.3d 1360, 1367 (Fed. Cir. 2000).

14 A. Anticipation

15 Defendant contends that claims 1, 2, 6, 11, 12 and 13 are
16 anticipated by U.S. Patent No. 5,815,830 (Anthony) and an
17 article by Paul Thistlewaite. Plaintiff contends that, as a
18 matter of law, Defendant does not and cannot provide clear and
19 convincing evidence that claim 8 is anticipated by any prior
20 reference. Because the Court found that, even under the
21 doctrine of equivalents, claims 2, 8, 12 and 13 were not
22 infringed, the Court considers only claims 1, 6 and 11. See
23 Phonometrics, Inc. v. N. Telecom Inc., 133 F.3d 1459, 1468
24 (Fed. Cir. 1998) (district court has discretion to dismiss as
25 moot a counterclaim alleging that a patent is invalid where it
26 finds no infringement).

1 1. Legal Standard

2 "A patent is invalid for anticipation when the same device
3 or method, having all of the elements contained in the claim
4 limitations, is described in single prior art reference."

5 Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367,
6 1375 (Fed. Cir. 2002); see also Scripps Clinic & Research Fdn.
7 v. Genentech, Inc., 927 F.2d 1565, 1576 (Fed. Cir. 1991)

8 ("Invalidity for anticipation requires that all of the elements
9 and limitations of the claim are found within a single prior
10 art reference."). "An anticipating reference must describe the
11 patented subject matter with sufficient clarity and detail to
12 establish that the subject matter existed in the prior art and
13 that such existence would be recognized by persons of ordinary
14 skill in the field of invention." Crown Operations, 289 F.3d
15 at 1375. "The question of what a reference teaches and whether
16 it describes every element of a claim is a question for the
17 finder of fact." Med. Instrumentation & Diagnostics Corp. v.
18 Elekta AB, 344 F.3d 1205, 1221 (Fed. Cir. 2003).

19 2. Description of Prior Art

20 a. Anthony

21 Andre Charles Anthony filed his patent application on
22 December 18, 1995; the patent, entitled "Automatic Generation
23 of Hypertext Links to Multimedia Topic Objects" issued on
24 September 29, 1998. Kirk Dec., Ex. A. Anthony is prior art to
25 the '647 patent under 35 U.S.C. § 102(e).

26 The patented technology in Anthony relates to methods and
27 systems of information management and, more specifically, to

1 hypertext information retrieval and display. Id. at 1:5-8.
2 The object of the patented technology was to provide a method
3 of arranging and retrieving data in a computer which did not
4 require a time-consuming authoring process. The patented
5 technology provides a structure for cross-referencing text
6 which does not require manual authoring of cross-reference
7 links, and therefore reduces the time and effort required to
8 produce and maintain hypertext documents. The patented
9 technology further eliminated the need for the author to
10 identify a word or phrase in which to embed codes to indicate
11 the existence of a cross reference, or to specify instructions
12 for navigation to the referred text. Id. at 3:16-25. Because
13 the text stored is compared, and associated, with topic names
14 at the moment of display, the links between text portions are
15 always up to date. Id. at 3:47-50. The patented technology
16 provides links, "meaning that the word or phrase in the text
17 found to be a match with a topic name is highlighted on the
18 display, and linked to the topic to which the topic name
19 refers." Id. at 5:6-12. The user can then jump to the
20 associated topic by selecting the highlighted word or phrase in
21 the first topic text.

22 b. Thistlewaite

23 Paul Thistlewaite's article, Automatic Construction and
24 Management of Large Open Webs, 33 Information Processing &
25 Management, 161-73, was published in March, 1997, and is prior
26 art to the '647 patent. Kirk Dec., B. The abstract notes that
27 many researchers have commented on the difficulties associated

1 with manually created or maintained hyperdocument links and the
2 consequent need for automated methods. The article describes a
3 system for the automatic detection and management of structural
4 and referential links, specifically addressing the issues
5 engendered by large volatile hyperbases. The article concludes
6 with a case study, describing the use of the approaches
7 advocated in the paper to build a hyperbase of the complete
8 electronic documents holdings of the Australian Parliament.

9 Although this is a single article, Plaintiff contends that
10 it is not a single reference as required for purposes of
11 anticipation. According to Plaintiff, while Defendant attaches
12 only this one article, Dr. Croft's expert report and claim
13 chart incorporate multiple articles by this author and another
14 author relating to this system and the Australian Parliament
15 case study. Defendant responds that it has made clear that it
16 is relying on this single article, and that Dr. Croft
17 concludes, and his invalidity claim chart shows, that each and
18 every element of claims 1, 2, 6, 11, 12 and 13 is present in
19 this article. The claim chart states that the Thistlewaite
20 article and the systems described therein anticipate the
21 alleged claims. There is a footnote after "systems described
22 therein" that lists three additional references "describing
23 this same system"; the three additional references are cited in
24 the claim chart. Croft Dec., Ex. D at 1, n.1. Before their
25 citations, however, is a "see also," indicating that these
26 additional references only provide additional support for a
27 proposition already supported. The Court will consider the
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1 Thistlewaite article as a single reference, without relying
2 upon any of the additional support provided by the other
3 references.

4 3. Anticipation of Claims 1, 6 and 11

5 Claim 1 consists of:

6 A computer-implemented method of dynamically generating
7 hypertext links from a source document to at least one
8 document other than the source document, comprising:
9 receiving a user selected portion of the source
10 document;
11 selecting a plurality of terms from the user
selected portion; and
for at least one selected term, automatically
creating at least one hypertext link to a document,
other than the source document, relevant to the
term.

12 Claim 6 depends on claim 1 and further requires the creation of
13 a menu of hypertext links. Claim 11 is similar to claim 1,
14 except that it does not require "selecting a plurality of terms
15 from the user selected portion."

16 Defendant's expert concludes that these three claims are
17 anticipated by many different works of prior art. Croft Dec.,
18 Ex. B at 20, 33-35. Plaintiff, however, provides no expert
19 testimony regarding the validity of these claims. His rebuttal
20 expert testified only that claims 2, 3, 8, 9, 10 and 12 are
21 valid in spite of the prior art references presented by
22 Defendant's expert. Plaintiff responds that his decision not
23 to offer expert testimony on the validity of claims 1, 6 and 11
24 is irrelevant; he notes that there is no requirement that a
25 plaintiff offer expert testimony about claims upon which the
26 defendant bears the burden of demonstrating invalidity.

27 Plaintiff does not have to offer expert testimony, but he
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1 does have to offer some evidence. Although the ultimate burden
2 of proof remains on Defendant, once it comes forward with clear
3 and convincing evidence to establish invalidity, the burden of
4 production of evidence shifts to Plaintiff. See TP Labs., Inc.
5 v. Professional Positioners, Inc., 724 F.2d 965, 971 (Fed. Cir.
6 1984) (if a prima facie case is made, "the patent owner must be
7 able to point to or must come forward with convincing evidence
8 to counter that showing"). Here, Dr. Croft's expert report and
9 claim charts provide a clear and convincing prima facie case of
10 anticipation of claims 1, 2, 6, 11, 12 and 13. Yet, as noted
11 above, Plaintiff has no expert or other evidence to show that a
12 dispute exists with respect to claims 1, 6 and 11. As
13 Defendant notes, "Attorney argument is no substitute for
14 evidence." Enzo Biochem, Inc. v. Gen-Probe, Inc., 424 F.3d
15 1276, 1284 (Fed. Cir. 2005).

16 Plaintiff offers little more than attorney argument.
17 Citing Anthony, Plaintiff states that the links created in
18 Anthony are the created in the absence of any "user selected
19 portion," as required by claims 1, 6 and 11. Defendant notes,
20 however, that Plaintiff does not address the Court's
21 construction of "user selected portion," which is "the entirety
22 or part, as chosen by the user, of a document accessed by the
23 user, wherein the user can choose the entirety of the document
24 by accessing the document." In Anthony, the entirety of a
25 document is selected by the user and accessed from a database
26 in the first step in the system's search for relevant terms;

1 thus, it discloses what Plaintiff claims it does not disclose.
2 See Kirk Dec., Ex. A at 4:53-63. Plaintiff presents no other
3 evidence. Because Plaintiff has failed to show a factual
4 dispute, the Court grants summary judgment that claims 1, 6 and
5 11 are invalid as anticipated by Anthony.

6 With respect to Thistlewaite, Plaintiff contends that
7 Defendant did not meet its burden of establishing a prima facie
8 case because, in order to anticipate the '647 patent, the
9 article must be enabling. He notes that Defendant does not
10 provide any testimony or evidence that would demonstrate how
11 Thistlewaite enabled one of ordinary skill in the art to
12 practice the patented technology recited in claims 1, 6 and 11.
13 Defendant does not claim to have provided such evidence;
14 instead, it responds that Thistlewaite is presumptively
15 enabling. But the case on which it relies did not hold that
16 prior art printed publications are presumptively enabling. See
17 Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1355
18 (Fed. Cir. 2003). Rather, the court noted "that by logical
19 extension" its reasoning that the prior patent was
20 presumptively enabled "might also apply to prior art printed
21 publications as well, but as Sugimoto is a patent we need not
22 and do not so decide today." Id. at 1355 n.22. Because the
23 Court has found that claims 1, 6 and 11 are anticipated by
24 Anthony, it need not decide whether Thistlewaite is
25 presumptively enabling.

26 B. Obviousness

27 Plaintiff contends that, as a matter of law, Defendant
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1 does not, and cannot, provide clear and convincing evidence
2 that claim 8 is invalid for obviousness. Because the Court
3 found that, even under the doctrine of equivalents, claim 8 was
4 not infringed, the Court will not consider whether Defendant's
5 claim of obviousness fails as a matter of law. See
6 Phonometrics, Inc., 133 F.3d at 1468.

7 CONCLUSION

8 For the foregoing reasons, the Court GRANTS Defendant's
9 Motion for Summary Judgment (Docket No. 196). The Court GRANTS
10 Defendant summary judgment that its smart tags do not literally
11 infringe the '647 patent and do not infringe claims 2, 8, 12
12 and 13 by equivalents. Although there is a dispute of facts as
13 to whether smart tags infringe claims 1, 6 and 11 by an
14 equivalent of the hyperlinks limitation, the Court further
15 GRANTS summary judgment that claims 1, 6 and 11 are invalid as
16 anticipated by Anthony. Because there is no infringement of
17 claims 2, 8, 12 and 13, the Court DISMISSES as moot Defendant's
18 counter-claim that these claims are invalid. The Court GRANTS
19 IN PART Plaintiff's Motion for Partial Summary Judgment (Docket
20 No. 166) and DENIES it IN PART.⁵ The Court GRANTS Plaintiff
21 summary judgment that Defendant's theories of invalidity under
22 §§ 101 and 112 and laches fail, as a matter of law, but the
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24 ⁵In addition, the Court DENIES Defendant's Motion to Strike
25 Inadmissible Evidence (Docket No. 189) and Plaintiff's Motion to
26 Strike Inadmissible Evidence (Docket No. 211). To the extent that
27 the Court relies upon evidence to which there is an objection, the
28 parties' objections are overruled. To the extent that the Court
does not rely on such evidence, the parties' objections are
overruled as moot.

1 Court DENIES Plaintiff's motion for summary judgment that
2 Defendant infringes claims 1, 2, 6, 8, 11, 12 or 13 of the '647
3 patent and that claim 8 is valid as neither anticipated nor
4 obvious. Judgment shall enter accordingly. Defendant shall
5 recover its costs from Plaintiff.

6 IT IS SO ORDERED.

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10 Dated: 3/10/06

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CLAUDIA WILKEN
United States District Judge